

REMARKS

The Title of the invention is modified according to the Examiner's request of Section 1 of the Office Action, and withdrawal of the objection is requested.

The objections to the drawings of Figure 3 which misses the description of reference signs 14, 16, 18, and 20 and of Figure 2F which misses the description of reference signs 26 and 28 according to Section 2 of the Office Action are corrected by amending the specification by adding the missing reference sign descriptions.

Claims 1-2, 5-6 and 9-10 are rejected under 35 USC 102(b) as being anticipated by Smith et al. (USP 5,923,327).

Regarding independent claims 1, 5 and 9, the Examiner's interpretation of the Smith et al. patent description needs further clarification in order to distinguish the present invention from that reference.

The Examiner alleges that Smith et al. teach "a computer-readable medium encoded with a data structure for use in providing a graphical icon for display on display of a portable communication device, characterized in that said data structure is encoded as digital data indicative of said graphical icon defined by alternating light and dark stripes, that selected stripes of said light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon, and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance".

Smith et al. in Figure 10 show an example of a simple screen for creating or modifying an icon. For example, Smith et al. state that (column 7, line 67 through column 8, line 2):

"In the example icon editing screen 1010, a user has selected to edit an existing home icon. Icon edit program 535 displays the actual size icon in an icon view button 1013 as it would appear in the name list. Icon edit program 535 also provides an enlarged view of the icon in an icon bitmap view 1014. The user may erase or draw in the bits of the icon using eraser button 1011 and draw button 1012.

Alternatively, rather than using erasure button 1011 or draw button 1012, a user may turn on or off each bit of the icon simply by touching each block of icon shown in icon editing screen 1010. In this embodiment, a user may utilize erasure button 1011 and draw button 1012 to erase or draw a large section of the icon."

Though Smith et al. describe editing an icon (e.g., enlarging, erasing part of the icons, or modifying some of its bits), they do not describe, mention or even hint at anything about dark or light stripes in a graphical icon, or that "selected stripes of the light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon" as stated in independent claims 1, 5 and 9 of the present invention. Furthermore, Smith et al. do not mention or describe a three-dimensional appearance of the graphical icon as a result of combination of light and dark stripes with shadows and highlights, which is the main goal of the present invention as

stated in the independent claims 1, 5 and 9.

Thus, claims 1,5 and 9 of the present invention are not anticipated by Smith et al, as alleged by the Examiner.

Claim 2, 6 and 10 are dependent claims of independent claims 1, 5 or 9, respectively. Since independent claims 1, 5, and 9 are not anticipated by Smith et al., as shown above, dependent claims 2,6 and 9 referred to novel independent claims 1,5 or 9 are also novel, and, therefore, it is not anticipated by Smith et al. under 35 USC 102(b).

Withdrawal of the 35 U.S.C. 102(b) rejection of claims 1-2, 5-6 and 9-10 is requested.

Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.(USP 5,923,327) in view of Hess et al.

Again, claims 3-4, 7-8 and 11-12 are dependent claims of independent claims 1, 5 or 9, respectively. Independent claims 1, 5, and 9 are not anticipated by Smith et al., as shown above, or by Smith in view of Hess et al. Since each of the dependent claims 3-4, 7-8 and 11-12 narrows the scope of novel and non-obvious independent claims 1 5, or 9, non-obviousness of claims 11, 5 or 9 will compel non-obviousness of claims 3-4, 7-8 and 11-12. Therefore, claims 3-4, 7-8 and 11-12 are not anticipated by Smith et al. in view of Hess et al. under 35 USC 103(a).

Another way to object to the 35 U.S.C. 103(a) rejection of claims 3-4, 7-8 and 11-12 is by analysing MPEP guidelines which are stated in the MPEP paragraph 2143 as follows:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

First, Smith et al., in view of Hess et al., do not teach or suggest all the limitations of claims 3-4, 7-8 and 11-12, as required by the MEMP paragraph 2143 to establish a *prima facie* case of obviousness. In particular, as stated above none of these references describe, mention or even hint at anything about dark or light stripes in a graphical icon, or that "selected stripes of the light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of said icon and from dark to light and back to dark shadow adjacent an edge of said icon and from dark to light and back to dark to indicate a highlight adjacent another edge of said icon and that altogether said light and dark stripes with shadows and highlights provide said icon with a three-dimensional appearance" as stated in dependent claims 3-4, 7-8 and 11-12 (through their dependence of independent claims 1, 5 or 9) of the present invention.

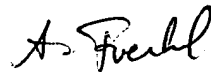
Second, there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by either Smith et al., or by Hess et al., or generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings to enable claims 3-4, 7-8 and 11-12 of the

present invention. Finally, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to find the solution claimed by the Applicant without the benefit of hindsight.

Withdrawal of the 35 U.S.C. 103(a) rejection of claims 3-4, 7-8 and 11-12 is requested.

The objections and rejections of the Official Action of August 8, 2003, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is solicited.

Respectfully submitted,



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